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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,830	10/18/2001	Yawcheng Lo	82992PCW	7053

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EXAMINER	
BEKERMAN, MICHAEL	
ART UNIT	**PAPER NUMBER**
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/981,830	LO ET AL.	
	Examiner	Art Unit	
	MICHAEL BEKERMAN	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/12/2008 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 10, 16, and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 10, this claim recites the limitation “storing the image on the storage medium with the correlated advertisement”. The specification states that the images may be received from a storage medium, and that advertisements may be

placed on that storage medium. The specification also states that the images may be re-formatted onto a video CD or DVD. However, nowhere in the specification does it state that the images are placed, by the kiosk, onto the storage medium that the advertisements were placed on. In fact, Examiner is confused after reading the specification as to why the kiosk would place images back on a storage medium that would already house the images to begin with.

Regarding claim 16, this claim recites the limitation "the means for placing also places the image on the storage medium along with the one or more correlated advertisements". The specification states that the images may be received from a storage medium, and that advertisements may be placed on that storage medium. The specification also states that the images may be re-formatted onto a video CD or DVD. However, nowhere in the specification does it state that the images are placed, by the kiosk, onto the storage medium that the advertisements were placed on. In fact, Examiner is confused after reading the specification as to why the kiosk would place images back on a storage medium that would already house the images to begin with.

Regarding claim 18, this claim recites the limitation "the storage medium comprises a non-digital storage medium". The specification lacks any definition for what a "non-digital storage medium" could comprise. While the specification has support for pre-printed or print-on-demand advertisements, printed matter is not considered to be a "storage medium".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claim 18, this claim recites the limitation "the storage medium comprises a non-digital storage medium". While Examiner considers such items as a filing cabinet or a desk drawer to be non-digital storage mediums, the specification shows no support for this. While the specification has support for pre-printed or print-on-demand advertisements, printed matter is not considered to be a "storage medium". Therefore, it is unclear as to what the Applicant is trying to claim by adding the limitation "non-digital". For the purpose of applying prior art, any type of medium that may house (or store) a digital storage medium would be considered to meet this limitation, as it would store the digital storage medium which stores the advertisements.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 1-3 and 5-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ko (U.S. Pub No. 2001/0044742) in view of King (U.S. Pub No. 2002/0055373), and further in view of Lipson (U.S. Patent No. 5,963,670).**

Regarding claims 1-3, 5, 6, 9, 11, 13-15, 17, and 19, Ko teaches extracting information from content on a disc (date/time information) (Paragraph 0035), correlating the extracted information to pre-determined advertisements (checking for updates based on the extracted date/time information) (Paragraphs 0039 and 0040), and placing the correlated advertisement on the disc (Paragraph 0041). The time information that is extracted from the disk is information related to the use of an electronic device. The computer taught by Ko in the cited sections is considered to be a kiosk computer.

While Ko teaches determining appropriate advertisements based on content extracted from the disc, Ko does not appear to specify extracting specific image content. King teaches a method of matching advertisements (services such as "vacation opportunities") to specific content information associated with picture files (Paragraphs 0030 and 0038). To match a vacation opportunity to an image, there must inherently be some form of classification performed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to target advertisements based on any information that could be extracted from the disc of Ko, including the type of information taught by King. This would allow for better reception of the advertisement by the user.

While King teaches targeting advertisements based on information associated with images, neither Ko nor King appear to specify computer-analyzing images to

receive such specific image content. Lipson teaches a method of computer-analyzing images to extract scene classification, face recognition, and biological motion (Column 2, Line 56 - Column 3, Line 17). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a computer to extract such information from images. Not only would this eliminate unneeded human error, but should there be no information provided with an image in the system of King, information could be extracted and provided on the spot.

Regarding claims 7 and 8, the following is a definition for the term meta-data from Merriam-Webster online dictionary:

> Main Entry: **meta·da·ta**
> Pronunciation: \-'dā-tə, -'da- *also* -'dä-\
> Function: *noun plural but singular or plural in construction*
> Date: 1983
> : data that provides information about other data

Once information is extracted, that information is inherently meta-data as it is data that provides information about other data.

Regarding claims 10 and 16, information used to target advertisements is extracted from data that already resides on the disc. Therefore, this data had to have been stored on the disk.

Regarding claim 12, Ko teaches image, video, and audio advertisements (Paragraphs 0031 and 0032).

Regarding claim 18, Ko, King, and Lipson do not appear to specify a “non-digital storage medium”. Official Notice is taken that recording disc carrying cases are old and well-known. Best buy has numerous examples of such cases on the music CD and

movie DVD aisles. It would have been obvious to one having ordinary skill in the art at the time the invention was made to store the disc of Ko in a protective case in order to keep the disc from being damaged.

ALTERNATIVE Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **ALTERNATIVELY, Claims 1-3, 5-13, and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Gindele (U.S. Patent No. 6,785,421).** Gindele teaches a method of targeting promotional items based on pictures that includes all of the limitations recited in the above claims.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 1-3, 5, 9, 11-13, 15, and 17, Gindele teaches extracting image content from a user storage device and analyzing it (Column 2, Lines 16-30), correlating an advertisement for a product or service to the image (Column 2, Lines 16-30), and returning the advertisement to the user storage device to be displayed (Column 7, Lines 29-50). Gindele also teaches extracting place information from the pictures and categorizing pictures according to that extracted information (Column 9, Lines 1-3). The computer taught by Gindele in the cited sections is considered to be a personal kiosk computer.

Regarding claim 6, computer of Gindele inherently has memory, and that memory is considered to be a memory card.

Regarding claims 7 and 8, Gindele teaches using meta-data to describe and categorize an image (Figure 7).

Regarding claims 10 and 16, information used to target advertisements is extracted from data that already resides on the storage medium. Therefore, this data had to have been stored on the storage medium.

Response to Arguments

Due to the amended claim language, new rejections have been applied. These new rejections are believed to fully address Applicant's arguments.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMAN whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Bekerman/
Examiner, Art Unit 3622